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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,561	11/09/2000	Toshiaki Nakano	P107156-00028	2262

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EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,561

Applicant(s)

NAKANO, TOSHIAKI

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 – 9 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of US Patent No. 6,477,526 [hereinafter '526 patent], and claims 6-9 of US Patent No. 6,532,475 [hereinafter '475 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

As per claim 1, the instant applicant claims:

A map-information providing system through a computer network for transmitting map image data ...,

wherein said map-information providing site has a map-information providing server ...,

wherein said map database site has a map-information database storing

The claims of '526 and '475 patents do not specifically state a map database site as described in the claim 1 of instant application, however it would have been obvious to a person skill in the art to recognize that the set of claims are similar because main server and router calculation server of '526 patent and first server and second server of '475 patent perform the functions of the map database site of the instant application which is providing map data to a terminal device through a network.

As per independent claims 2-7, they are also directed to the same subject matter recited in claim 1 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirono [US Patent No 6,263,343], in view of Delorme et al. [US Patent No 5,948,040].

6. As per claim 1, Hirono discloses the invention substantially as claimed including a map-information providing system through a computer network [Figure 1] for transmitting map

image data corresponding to a designation entry [Figure 2A] from a map database site to an information terminal for display [Figure 1-1] when the designation entry for a request to provide a map image [Figure 2B] to the information terminal has been made on an information providing screen presented from a map-information providing site [col 3, lines 55-col 4, lines 51],

wherein said map-information providing site has a map-information providing server for displaying the information providing screen for making the designation entry for the request to provide the map image to the information terminal [col 4, lines 52-col 5, lines 12],

wherein said map database site has a map-information database storing map image data [1, Figure 1], a retrieval database storing retrieval data for retrieving the map image data corresponding to said designation entry from said map-information database [2, Figure 1].

Hirono does not specifically disclose

a map server for comparing said designation entry made on said information providing screen with said retrieval database to read out the map image data corresponding to the designation entry from said map-information database, and sending the read-out map image to the information terminal.

Delorme discloses

a map server for comparing said designation entry made on said information providing screen with said retrieval database to read out the map image data corresponding to the designation entry from said map-information database [col 8, lines 23-48; and col 16, lines 60-col 17, lines 13], and sending the read-out map image to the information terminal [col 10, lines 47-58].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hirono and Delorme because Delorme's teaching of a map server would provide a fully integrated system which can allow user to customize the desired output.

7. As per claim 2, Hirono discloses wherein the retrieval data stored in said retrieval database comprises position data representing the correspondence between the designation entry translated into said required information form and coordinates on a map [Figure 2A and 2B; and col 4, lines 9-22], and data representing the correspondence between the position data and the map image data stored in said map-information database [col 4, lines 30-47].

8. As per claim 3, Hirono discloses wherein the retrieval data stored in said retrieval database comprises data representing the correspondence between the designation entry translated into said required information form and the map image data stored in said map-information database [Figures 3-6; and col 5, lines 3-59].

9. As per claim 4, Hirono does not specifically disclose wherein said information terminal is a mobile terminal having an Internet access function. Delorme discloses wherein said information terminal is a mobile terminal having an Internet access function [Abstract, lines 31-33; and col 16, lines 32-59]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hirono and Delorme because Delorme's teaching of mobile terminal would provide an portability aspect to the system of Hirono.

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10. As per claim 5, Hirono discloses wherein said information providing screen is a World Wide Web page [Figure 2A; and col 4, lines 9-22 and lines 52-59].

11. As per claim 6, Hirono does not specifically disclose wherein said information providing screen is an information display screen displayed on a display of a mobile terminal having an Internet access function. Delorme discloses wherein said information providing screen is an information display screen displayed on a display of a mobile terminal having an Internet access function [col 75, lines 33-45]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hirono and Delorme because Delorme's teaching of displayed on a display of a mobile terminal would allow to provide necessary information to multiple connected networks which include both wired and wireless network without any limitations.

12. As per claim 7, Hirono discloses wherein said map-information providing server is a corporation server [Figure 1-1; and col 8, lines 14-29].

13. As per claim 8, it is rejected for similar reasons as stated above in claim 1. Furthermore, Hirono does not specifically disclose wherein a charge of providing the map image data from said map database site is issued to a user of said information terminal. Delorme discloses wherein a charge of providing the map image data from said map database site is issued to a user of said information terminal [col 61, lines 65-col 62, lines 28]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hirono and

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Delorme because Delorme's teaching of charge for providing the map image data would allow to control user's access and to maintain information integrity.

14. As per claim 9, it is rejected for similar reasons as stated above in claim 1. Furthermore, Delorme discloses wherein a charge for providing the map image data from said map database site is issued to management of said map-information providing site [col 61, lines 3-64].

15. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen


ZARNI MAUNG
PRIMARY EXAMINER